

**SUMMA &
ALLAN, P.A.**
PATENT ATTORNEYS

11610 NORTH COMMUNITY HOUSE RD.
SUITE 200
BALLANTYNE CORPORATE PARK
CHARLOTTE, NC 28277
T: 704.945.6700
F: 704.945.6735
W: WWW.PRUMMA.COM

FACSIMILE TRANSMITTAL SHEET

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☐ URGENT ☐ FOR REVIEW ☐ PLEASE COMMENT ☐ PLEASE REPLY ☐ PLEASE RECYCLE

NOTES/COMMENTS:

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DEC 20 2002

PETITIONS OFFICE

Inventors: Pillai et al.
Ser. No. 09/977,127
Filed 10/12/01
For: Heterogeneous Pd Catalysts and
Microwave Irradiation in Heck Arylation

- Request for Reconsideration of Petition Under 37 CFR 1.47(a) and Petition for Waiver of 37 CFR 1.63(a)(2) Pursuant to 37 CFR 1.183
- Credit Card Payment Form

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Attorney Docket No. 1700.109**PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re: Pillai et al.

Serial No.: 09/977,127

Group Art Unit 1711

Filed: October 12, 2001

For: HETEROGENEOUS Pd CATALYSTS AND
MICROWAVE IRRADIATION IN HECK ARYLATION

December 20, 2002

Assistant Commissioner for Patents
Box DAC - Office of Petitions
Washington, DC 20231**REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 CFR 1.47(a)
AND PETITION FOR WAIVER OF 37 CFR 1.63(A)(2)
PURSUANT TO 37 CFR 1.183**

Sir:

This Request for Reconsideration (Request) is in response to the Patent Office's Decision Dismissing Applicant's Petition under 37 CFR § 1.47 (Paper No. 6) (the Decision). In that Decision, the Patent Office rejected Applicant's § 1.47(a) Petition because the declaration submitted by Applicant in support of the § 1.47(a) Petition identified a non-signing inventor by family name and initial ("A. Wali") rather than by family name and given name as required by 37 CFR § 1.63(a)(2). Pursuant to 37 CFR § 1.183¹, Applicant respectfully requests that the Commissioner waive the requirement that a non-signing inventor must be identified by a given name rather than an initial. The circumstances underlying this request constitute an extraordinary situation in which the Commissioner's waving of this requirement is justified in the interests of justice.

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Recent Events

On December 20, 2002, one (1) business day before this Request was due, Applicant's undersigned attorney of record received a message that the initial "A" of coinventor Wali stands for the given name "Anil." Given this short time frame,

¹ 37 CFR § 1.183: In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accomplished by the petition fee set forth in § 1.17(h).

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Applicant respectfully requests that the substantive issues discussed in the remainder of this Request be favorably considered by the Assistant Commissioner. Although Applicant may eventually be able to have a new Declaration (carrying the full name Anil Wali) executed and resubmitted, Applicant does not expect to be able to do so between December 20 and December 23 because the last known address of the one available inventor is in the Netherlands.

Background

The facts underlying the present Request and the ultimate issues to be resolved appear to be of first impression in the U.S. Patent System. On October 24, 2000, U.S. Patent 6,136,157 (the '157 Patent) issued to Lindcburg, *et al.* for technology related to microwave assisted chemistry. CEM Corporation of Matthews, North Carolina (CEM), develops and manufactures microwave technology similar to that discussed in the '157 Patent. CEM is aware of prior art that CEM believes will invalidate the '157 Patent. Specifically, CEM is of the opinion that the Applicant and the non-signing inventors are prior inventors of subject matter included within the scope of the '157 Patent's claims. As is evident from the Exhibits attached to Applicant's Section 1.47(a) Petition, CEM is the party in interest behind the present application. Accordingly, the majority of this Request references CEM rather than the Applicant.

The application is based upon work completed in India by three Indian nationals prior to October 17, 1995. This work is described in a document published in 1997. Accordingly, no valid patent can issue from CEM's application. 35 U.S.C. § 102. Nevertheless, CEM prepared and filed the present application for purposes of provoking an interference proceeding in the U.S. Patent Office to demonstrate the priority of inventorship of the named inventors over the '157 patentees and thus demonstrate the invalidity of the '157 Patent. The Federal Circuit has specifically

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held that provoking an interference for purposes of establishing priority of inventorship, even when § 102 bars the claimed invention, is appropriate in light of the overriding legislative objective of settling rights between parties and rights of concern to the public. *Perkins v. Kwon*, 886 F.2d 325, 328 (Fed. Cir. 1989). Preventing "the issuance or preservation of a facially invalid patent" is one such overriding objective. 886 F.2d at 328-329.

Through extraordinary efforts CEM, was able to obtain a declaration and power of attorney from one of the Indian inventors, Dr. Shco Satish. As documented in CEM's Section 1.47(a) petition, the two remaining inventors have not as yet signed the inventors' declaration. The two remaining inventors are both identified as authors on the publication that serves as the basis for the application, and the publication identifies them as Dr. S. Muthukumar Pillai and Dr. A. Wali. On information and belief, both Dr. Pillai and Dr. Wali currently reside in India.

The Patent Office rejected CEM's § 1.47(a) Petition because Dr. A. Wali is only identified by his initial "A" in the declaration. In support of the rejection the Office cites 37 CFR § 1.63(a)(2) which states:

(a) An oath or declaration filed under § 1.51(b)(2) as part of a nonprovisional application must:

(2) Identify each inventor by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial;...

Despite diligent efforts, including a recent attempt to contact Dr. Pillai through an email account believed to be under his control, CEM was unable to ascertain a given name for Dr. Wali prior to December 20, 2002². Although CEM's efforts to

² "Recent Events" page 1 herein

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ascertain a given name for Dr. Wali may have proven fruitful, CEM will not be able to provide a revised and executed Declaration prior to December 23, 2002—the deadline for this response. Accordingly, CEM requests that the Commissioner invoke his authority under 37 CFR § 1.183 to suspend the requirement in 37 CFR § 1.63(a)(2) that each inventor be identified by a given name. CEM is of the opinion that the circumstances surrounding this request and the public policy issues involved justify the exercise of the Commissioner's authority.

Issue 1

May the Commissioner invoke his authority under 37 CFR § 1.183 to suspend the requirement in 37 CFR § 1.63(a)(2) that each inventor be identified by a given name?

Short Answer

Yes. The Commissioner is authorized to invoke his authority under 37 CFR § 1.183 to suspend the requirement in 37 CFR § 1.63(a)(2) because the requirement that each inventor be identified by a given name is not required by statute.

Issue 2

Should the Commissioner exercise his authority under 37 CFR § 1.183 and suspend 37 CFR § 1.63(a)(2) and allow an application to proceed for purposes of provoking an interference?

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Short Answer

Yes. The Federal Circuit has held that resolving questions of priority of inventorship and resolving questions of patent validity are part of the Patent Office's mission to grant presumptively valid patents under 35 U.S.C. § 282.

The Requirement That Each Inventor be Identified by a Given Name is Not Required by Statute.

The only limitation on the Commissioner's exercise of authority under 37 CFR § 1.183 is that any requirement waived by the Commissioner must not be a requirement of the statutes. The requirement at issue is not a "requirement of the statutes" for purposes of 37 CFR § 1.183.

35 U.S.C. § 115 governs the "Oath of applicant."³ This statute requires that an inventor identify himself or herself (by making the oath) and identify the inventor's country of citizenship. 35 U.S.C. § 116 governs inventors generally and states, "when an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath...." These are the only relevant statutory requirements placed upon the identification of the Indian inventors. Neither statute

³ 35 U.S.C. § 115: The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States, and such oath is valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him. For purposes of this section, a consular officer shall include any United States citizen serving overseas, authorized to perform notarial functions pursuant to section 1750 of the Revised Statutes, as amended (22 U.S.C. 4221).

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contains any requirement regarding how the inventor is identified nor any prohibition against initials. Therefore, the Patent Office's rule regarding the prohibition of initials is not a requirement of the statute and may be waived by the Commissioner.

Several rulings by Federal Courts and the Patent and Trademark Office support the above conclusion. One decision by the Trademark Trial and Appeal Board is almost directly on point. In the case of *In re Hardee*, 223 U.S.P.Q. 1122 (TTAB 1984), Mr. Hardee, an inventor, sought to remove Mr. Sud as a named inventor on an application alleging that Mr. Sud was erroneously added as an inventor. 35 U.S.C. § 116 states in part:

Whenever through error a person is named in an application for patent as the inventor, or through error an inventor is not named in an application, and such error arose without any deceptive intention on his part, the Director may permit the application to be amended accordingly, under such terms as he prescribes.

37 CFR § 1.48 prescribes the terms under which correction of inventorship may be accomplished. One of the terms of § 1.48 is a verified statement of facts signed by the originally named inventors. In *Hardee*, Mr. Sud refused to sign the statement of facts thereby precluding compliance with § 1.48. The TTAB held that the requirement in § 1.48 that all the original named inventors sign the statement of facts was waiveable under § 1.183. Thus, *Hardee* differentiates between general but mandatory statutory requirements and specific but waiveable implementing regulations.

Likewise, in the present case, 35 U.S.C. §§ 115 and 116 require that inventors provide an oath, yet say very little about the exact contents of the oath, and are silent regarding the use of initials in identifying inventors. Accordingly, under *Hardee*, the

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Patent Office's more specific requirements regarding use of initials in § 1.63(a)(2) is waiveable under § 1.183. Several analogous cases support this conclusion.

For example, 35 U.S.C. § 145 sets forth guidelines for filing an appeal of decisions from the Board of Patent Appeals to the District Court of the District of Columbia. This section states that the appeal should be "commenced within such time after such decision, not less than sixty days, as the Director appoints." The appointed time for filing such appeals is two months from the date of the Board's decision. 37 CFR § 1.304. The U.S. Court of Appeals for the District of Columbia held in *Eckey v. Watson*, 286 F.2d 891, 892 (D.C. Cir. 1959), that 37 CFR § 1.304 is not a requirement of the statutes "within the meaning of Rule 183 (now 37 CFR § 1.183) and that the rules as drawn, permit the Commissioner to suspend or waive the 60-day requirement of Rule 304." In other words, the statutory requirement for notice not less than 60 days cannot be waived, but the Commissioner's appointed date can be waived.

Similarly, in *Boutros v. Boutros*, 231 U.S.P.Q. 829 (Comm. of Pat. 1986) an inventor refused to execute an assignment to the United States Government as required by Executive Order and other regulations. Patent Office regulations required the assignment before terminating an interference action involving the invention. Given the facts of the case, the Commissioner held that the refusal of the inventor to sign the assignment was an extraordinary circumstance justifying waiving the assignment requirement. See also, *Land O'Lakes Creameries, Inc. v. Oconomowoc Canning Company*, 199 F.Supp. 124 (E.D. Wis. 1961); *In re Bryan*, 2 U.S.P.Q.2d 1215 (Comm. of Pat. 1986).

In short, § 1.63(a)(2) is equivalent to the regulations governing correction of inventorship, filing of appeals, and execution of assignments. Each of these

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regulations set forth specific requirements that are based upon statutory authority but are not required by the statutes. Accordingly, each may be waived by the Commissioner.

The Commissioner Should Exercise His Authority under 37 CFR § 1.183 and Suspend the Requirement That Each Inventor be Identified by a Given Name.

As noted previously, CEM believes that this is an issue of first impression in the U.S. Patent System because diligent efforts failed to locate any judicial opinions or administrative opinions on point. In fact, a database search of judicial opinions pertaining to 37 CFR 1.63(a)(2) identified only one case. A similar search of 37 CFR § 1.183 identified only about 72 cases. Although none of these cases are precisely on point, some of them (primarily those discussed previously) address analogous situations and support CEM's contention that the Commissioner should use his authority and suspend the requirement in 37 CFR § 1.63(a)(2) that each inventor be identified by a given name.

It is axiomatic that the U.S. Patent System is designed and operated to ensure, to the extent possible, issuance of valid patents. Accordingly, when questions of validity are presented to the U.S. Patent Office, the Office has a duty to investigate these issues and determine the validity of the patent in question. This statement of duty is clearly set forth in the Federal Circuit's opinion in *Perkins v. Kwon*, 886 F.2d 325 (Fed. Cir. 1989) (*Perkins*).

In *Perkins*, an alleged prior inventor (Kwon) filed an application to provoke an interference with a patent issued to another inventor (Perkins). An interference was declared and the Board of Patent Appeals found that Kwon was the prior inventor and canceled Perkins' patent. The Board also held that Kwon's application was barred

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under 35 U.S.C. § 102 because of an on-sale bar. Perkins appealed on the grounds that it was inappropriate for the Board to determine priority of invention in the interference and to cancel the patent when the invention at issue was not patentable to Kwon. Perkins argued that because Kwon was not entitled to a patent there was no basis for an interference between them and therefore Perkins' patent should stand as originally issued. The Federal Circuit rejected Perkins' argument.

In support of the rejection of Perkins' argument, the Federal Circuit reviewed the statutes and the legislative history relating to the operation of the Board and concluded that the Board is charged with the duty to determine issues of priority when such issues are raised.

It would similarly contradict the legislative purpose if the Board were to refrain from deciding priority, when the result of such restraint would be the issuance or preservation of a facially invalid patent. The Board, by resolving both priority and patentability when these questions are fully presented, settles not only the rights between the parties but also rights of concern to the public. The public interest in the benefits of a patent system is best met by procedures that resolve administratively questions affecting patent validity that arise before the PTO. To do otherwise is contrary to the PTO's mission to grant presumptively valid patents, 35 U.S.C. § 282, and thus disserves the public interest.

Perkins v. Kwon, 886 F.2d 325, 328-329 (Fed. Cir. 1989) (emphasis added).

Given the Federal Circuit's statements about the overriding public interest in having the Patent Office determine questions of priority in interference actions, the Commissioner should exercise his authority under 37 CFR § 1.183 and waive the requirement that Dr. Wali be identified by a given name. This is especially true under the facts of this case. Waiving this requirement will allow the provocation of an interference to determine the validity of a patent. Waiving this requirement will not create any long-term issues because the application is barred under 35 U.S.C. § 102.


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Furthermore, two of the three inventors are precisely identified and one has signed the required oath thus removing any arguments regarding the authenticity of the application.

Furthermore, obtaining the cooperation of an unavailable or uncooperative inventor is—by definition—impossible. In turn, requiring the cooperation or availability of such an inventor logically frustrates the underlying purpose of 37 CFR § 1.47. Therefore, given that inventor A. Wali remains unavailable to date, the Office's requirement that his given name be identified and submitted can and should be waived in these circumstances.

In short, the totality of the circumstances surrounding this Request and the Federal Circuit's directives toward settling questions of validity mandate waiving the requirements of 37 CFR § 1.63(a)(2).

Respectfully submitted,



Stanley B. Baker
Reg. No. 35,058

021176

Summa & Allan, P.A.

11610 N. Community House Road, Suite 200

Ballantyne Corporate Park

Charlotte, NC 28277-2162


Telephone: 704-945-6701

Facsimile: 704-945-6735

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted by facsimile to the Petitions Attorney Steven Brantley in the Office of Petitions, at Fax No. 703-308-6916, on December 20, 2002.



Stanley B. Baker